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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,084	03/26/2001	Michael E. Graves	12307/100173	2846
23838 7590 06/26/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
WORJLOH, JALATIE				
ART UNIT		PAPER NUMBER		
3685				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/818,084

Applicant(s)

GRAVES ET AL.

Examiner

Jalatee Worjloh

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 23, 2008 has been entered.
2. Claims 35-58 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 35-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Specifically, claims 35, 42 and 49 recite storing a public key at a payment authorization service, but the specification instead states that the authentication service stores secret information. Is the payment authorization service the same as the authentication service? If so, consider revising the claim to read "authentication service" or indicate where in the specification describes the payment authorization service storing the public key. Also, claim 35 recites

"linking the PKI key pair to at least a first payment instrument of a buyer", "determining that the buyer has access to the private key *and that the buyer is authorized to use the first payment instrument*", and "the authentication response including an indication that the buyer is authorized to use the first payment instrument"; however, the specification does not disclose a first payment instrument and the steps relating to the instrument. If Applicants disagrees, please clearly indicate where these features are disclosed.

6. Claims 40 and 47 recite "the buyer profile being linked to the PKI key pair"; however, the specification does not show this feature. If Applicants disagrees, please clearly indicate where this feature is disclosed.

7. Also, please indicate where support lays for newly added claims 56-58.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 35, 37-42, 44-49, 51-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6205437 to Gifford in view of U.S. Publication NO. 2004/0243520 to Bishop et al. ("Bishop") and US Publication N0. 2001/0044787 to Shwartz et al. ("Shwartz")

Referring to claims 35 and 42, Gifford discloses a payment authorization service, storing a public key associated with a public key infrastructure (PKI) key pair in a profile database (see col. 10, lines 37-42 – at the payment computer, the public key corresponding to

each sender is kept in a database), linking the PKI key pair to at least a first payment instrument (see col. 10, lines 48-67; col. 11, lines 1-7 - the smart card including a secret key is used to sign the payment order), in response to receiving an authentication request from the buyer over a network, the authentication request including a description of the payment transaction and an identity of a seller (see col. 6, lines 16-32), the seller separate from the payment authorization service (see Fig. 1, items 63 & 68), storing a digitally signed record of the payment transaction in a transaction archive, i.e. "transaction database" (see col. 8, lines 16-19), sending an authentication response to the seller over the network (see col. 6, lines 52-61). Gifford does not expressly disclose sending a challenge request to the buyer over the network, the challenge request including a summary of the payment transaction, in response to receiving a challenge response from the buyer over the network, the challenge response including summary of the payment transaction digitally signed by the buyer, determining that buyer has access to the private key and that the buyer is authorized to use the first payment instrument by using the public key to decrypt the digitally signed message. Bishop discloses sending a challenge request to the buyer over the network, in response to receiving a challenge response from the buyer over the network, the challenge response including summary of the payment transaction digitally signed by the buyer, determining that buyer has access to the private key and that the buyer is authorized to use a first payment instrument by using the public key to decrypt the digitally signed message (see paragraphs [0094] & [0095]). Schwartz discloses the challenge request including a summary of the payment transaction (see paragraphs [0182]-[0184]). As for the step where the authentication response including an indication that the buyer is authorized to use the first payment instrument, this is considered nonfunctional descriptive material and is not

functionally involved in the steps recited. The sending step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 UPSQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to generate and the search results including any type of data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Also, it would have obvious to one of ordinary skill in the art to modify Gifford to include the features taught by Bishop and Schwartz because it protects the network server from attacks and improve the ease and safety of electronic commerce for consumers (see Bishop & Shwartz).

Referring to claims 37, 44 and 51, Gifford discloses the method wherein the record of the payment transaction is digitally signed using the private key (see col. 10, lines 43-45).

Referring to claims 38, 45 and 52, Gifford discloses the method wherein the record of the online transaction is digitally signed using a local private key (see col. 10, lines 48 & 49).

Referring to claims 39, 46 and 53, Gifford discloses the method wherein the public key is stored in the form of a digital certificate representing that the public key is tied to the buyer (see col. 7, lines 44-46).

Referring to claims 40, 47 and 54, Gifford discloses several databases including account database storing account information and an address database storing shipping address information (see col. 8, lines 12-24 and 33-36) . Gifford also discloses receiving a selection of one of the plurality of payment instruments (i.e. "means of payment") and one of the plurality of

shipping addresses from the buyer over the network (see col. 5, lines 34-50; col. 8, lines 33-35). Gifford does not expressly disclose retrieving a buyer profile from the database, the buyer profile being linked to the PKI key pair and including a plurality of payment instruments and a plurality of shipping address and sending the buyer profile to the buyer over the network; however, these are inherent steps. Before selecting the method of payment and address information, the buyer must first be provided with his profile.

Referring to claims 41,48 and 55, Gifford discloses processing the payment transaction via a payment gateway (i.e. "payment computer") see col. 6, lines 12-14.

Referring to claim 49, Gifford discloses a profile database, i.e. account database and address database, transaction archive, i.e. settlement database" (see col. 7, lines 66-67 & col. 8, lines 1-7) an authentication service web server (i.e. "payment computer") coupled to the profile database, the transaction archive and the network, the authentication service web server adaptively configured to (see col. 4, lines 46-55) store a public key associated with a public key infrastructure (PKI) key pair in a profile database (see col. 10, lines 37-42), in response to receiving an authentication request from a buyer over a network, the authentication request including a description of the payment transaction and an identity of a seller (see col. 6, lines 16-32), store a digitally signed record of the payment transaction in a transaction archive, i.e. "transaction database" (see col. 8, lines 16-19) and send an authentication response to the seller over the network (see col. 6, lines 52-61). Gifford does not expressly disclose the web server adaptively configured to send a challenge request to the buyer over the network, the challenge request including a summary of the payment transaction to be displayed to the buyer then digitally signed by the buyer using a private key associate with the PKI key pair, or in response

to receiving a challenge response from the buyer over the network, the challenge response including the digitally signed summary of the payment transaction, determine whether the buyer has access to the private key by using the public key to decrypt the digitally signed summary of the payment transaction. Bishop discloses sending a challenge request to the buyer over the network, the challenge request message to be displayed to the buyer then digitally signed by the buyer using a private key associate with the PKI key pair, or in response to receiving a challenge response from the buyer over the network, the challenge response including the digitally signed message, determining whether the buyer has access to the private key by using the public key to decrypt the digitally signed message (see paragraphs [0094] & [0095]). Shwartz discloses the challenge request including a summary of the payment transaction (see paragraphs [0182]-[0184]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Gifford to include the steps of the web server adaptively configured to send a challenge request to the buyer over the network, the challenge request including a summary of the payment transaction to be displayed to the buyer then digitally signed by the buyer using a private key associate with the PKI key pair, or in response to receiving a challenge response from the buyer over the network, the challenge response including the digitally signed summary of the payment transaction, determine whether the buyer has access to the private key by using the public key to decrypt the digitally signed summary of the payment transaction. One of ordinary skill in the art would have been motivated to do this because it protects the network server from attacks and improve the ease and safety of electronic commerce for consumers (see Bishop & Shwartz).

As per claims 56-58, the combination of Gifford, Bishop, and Shwartz disclose these features (see claim 35 & 42 above).

10. Claims 36,43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford, Bishop et al. and Shwartz et al. as applied to claims 35, 42 and 49 above, and further in view of US Publication NO. 2001/0014158 to Baltzley.

Gifford discloses PKI key pair (see claims 35 and 42 above). Gifford does not expressly disclose creating the PKI key pair, and sending the private key to the buyer over the network. Baltzley discloses creating the PKI key pair (see paragraph [0010], and sending the private key to the buyer over the network (see paragraph [0011]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Gifford to include the steps of creating the PKI key pair, and sending the private key to the buyer over the network. One of ordinary skill in the art would have been motivated to do this because it prevents fraud by providing additional security.

Conclusion

Functional recitation(s) using the word “for” or other functional language (e.g. “adapted to” in claim 54) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

Art Unit: 3685

which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115.

Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

/Jalatee Worjloh/

Primary Examiner, Art Unit 3685

although all limitations must be considered, not all limitations are entitled to patentable weight).